REMARKS

Claims 1 - 10 remain active in this application. No new matter has been introduced into the application. The withdrawal of previous grounds of rejection based on prior art in view of the previous response is noted with appreciation.

Claims 1 - 6 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter; the Examiner opining that the claims are directed to subject matter that merely manipulates data or an abstract idea or solves a mathematical problem, and claims 7 - 10 have also been rejected (in three separate rejection statements) under 35 U.S.C. §101 as being drawn to non-statutory subject matter; the Examiner opining in each statement that the claims are drawn to non-functional descriptive material. These grounds of rejection and the Examiner's stated rationale underlying the same are respectfully traversed.

As stated in the response filed October 13, 2004, in regard to claims 1 - 6:

> "The invention is directed to a data format using flags to indicate whether or not the block of intermediate data or the intermediate data for an entire frame has certain commonly occurring features which result from data compression which ordinarily (for example, under the JPEG standard) must be detected by testing of each pair of bytes (used for each AC coefficient) for non-zero value coefficients and/or whether or not extra bits are required for unique coding of coefficient values and other processing such as loading (sixteen) zero-valued coefficients during decoding. By indicating either or both of these conditions on the compressed

data with flag bits for each block or frame,
such testing become unnecessary which reduces
by a factor of two to four the number of
memory read and write operations necessary to
obtain the coefficient information from the
compressed code (see page 14, lines 4 - 22)
and reduces processing time sufficiently to
allow other common operations such as
rotation to be performed with practical
levels of processing power."

In other words, the method recited calls for
testing of data for a specifically recited quality and
includes information representing the result of that
testing in the data itself so that the time and
processing overhead for performing such testing at a
later stage where processing power and time are at a
premium can be avoided.

Therefore, it is clearly seen that the invention
does, indeed, support production of (and "produces" to
the extent that the additional information added to the
data encoded as flags is not ignored during further
processing such as decoding) "a useful, concrete and
tangible result" and is thus manifestly statutory
subject matter as well as manifestly being an
application in the technological arts supporting a
physical transformation (e.g. image reconstruction
and/or manipulation) outside a computer as is both
disclosed and which is abundantly evident to those of
ordinary skill in the art, contrary to the Examiner's
assertions. Further, the method of coding recited in
these claims also manifestly supports accomplishment of
a practical application (particularly in regard to the
"testing recitation as previously recited and
especially as now amended), also contrary to the
Examiner's assertions.

Moreover, it is respectfully submitted that all of
claims 1 - 6, as currently rejected, already answer all

three of the Examiner's suggestions for establishing
that the claimed process produces a "useful, concrete
and tangible result. Specifically, claims 1 and 2 - 6,
depending therefrom all recite "coding *image* data into
at least one block of *data including a plurality of
coefficient values*" (emphasis added) which manifestly
represents a physical object or activity transformed
from outside the computer as well as pre-computer
processing activity (especially in regard to claims 2,
3 and 6 which recite additional transformations or
testing prior to at least the step of "using a flag..."
recited in claim 1 and a direct recitation of a
practical application in the technological arts.

Accordingly, it is respectfully submitted that the
ground of rejection asserted in regard to claims 1 - 6
is without basis in fact based of the explicit
recitations of the claims and the claims are already
free from the deficiencies the Examiner asserts (and
especially so in view of the amendments made above to
claim 1) and already embody the Examiner's suggestions
and are in conformance with the precedents on which the
Examiner evidently relies. The Examiner has clearly
failed to make any *prima facie* demonstration that the
claims are "devoid of any limitation to a practical
application" as is clearly not the case and,
particularly, the Examiner has not done so in the
manner required by M.P.E.P. §2106 (II)(A) discussed in
greater detail below. Therefore, reconsideration and
withdrawal of the rejection of claims 1 - 6 are
respectfully requested.

In regard to claims 7 - 10, it is respectfully
submitted that, while the claims are drawn to a data
format, they are not drawn merely to "non-functional
descriptive material" as the Examiner asserts. Again,
the recited data format includes, in addition to the
recited coefficient values in a block of data, "at
least one flag indicating if all said coefficient

values in said block are coded in eight bits or fewer
or if any requires more than eight bits to be uniquely
coded". This feature of the data format is clearly
functional since it supports the omission of testing
processes during further processing such as decoding of
the data and is also distinctive since it represents
information not ordinarily included in the data since
it is essentially redundant in the sense that it can be
determined/recovered from the remainder of the data
but, by the same token, represents a quality of the
data which allows control of interpretation of the data
(e.g. to determine which bits correspond to a
particular coefficient which is otherwise not
delineated in the data) without requiring that
information to be determined or recovered in the course
of such further processing where processing power
and/or processing time may be critical or at a premium,
especially if additional manipulations of the data
(within the same processing power and time constraints)
may be desired, as has been often found to be the case.

Thus, it is respectfully submitted that while a
claim directed to a particular data format may
necessarily be descriptive of that format (as any claim
must be descriptive of the subject matter of the
invention) it does not necessarily follow from the
quality of descriptiveness that the subject matter
described is non-functional. The recitations of first
and second pairs of bytes in the claimed format are
also functional in that a decoder can unambiguously
locate/detect them. By the same token, these
recitations also effectively specify an
interrrelationship between the data and the computer,
decoder or other processor, contrary to the Examiner's
apparent position in the quoted passages of the
M.P.E.P. (In this regard, it is also respectfully
submitted that the Examiner's assertion that a decoder,
such as for compressed image data, is not a computer is

not well-taken since general-purpose processors were
used for an extended period of time as decoders in
commercial set-top-boxes (STBs) and have been recently
replaced by special purpose processors. Similarly, the
Examiner's analogy to a program or algorithm embodied
on a computer readable medium is not well-taken since
the invention, as recited, includes additional
information which controls interpretation of other data
by a decoder and certainly constitutes an
interrelationship with the operation and function of a
decoder or other processor but does not control the
entirety of the processing.) On the contrary, the
M.P.E.P. clearly states (§2106 (II)(A)(paragraphs 6 and
7) that "[o]ffice personnel have the burden to
establish a *prima facie* case that the claimed invention
as a whole is directed to *solely* an abstract idea or
manipulation of abstract ideas or do not produce a
useful result" and that [o]nly when the claim is *devoid
of any limitation to a practical application in the
technological arts should it be rejected* under 35
U.S.C. 101" (emphasis added) and further indicates that
"[o]ffice personnel should ... focus their efforts on
pointing out statements in the specification which
identify practical applications for the invention" and
"should rely of such statements throughout the
examination when assessing the invention for compliance
with all statutory criteria" and further noting that
"only one [practical application] is necessary to
satisfy the utility requirement"; diametrically
contrary to the Examiner's apparent position in the
present office action. The features necessary to
accomplish at least one asserted practical application
are undeniably present in all of claims 1 - 10 and the
Examiner has made no demonstration to the contrary.
Therefore, it is respectfully submitted that the
asserted ground(s) of rejection of claims 7 - 10, as
well as the rejection of claims 1 - 6 is/are similarly

without basis in fact and, upon reconsideration, should
be withdrawn as untenable as contrary to statute,
precedent and practice of the USPTO as enunciated in
the M.P.E.P. and such action is respectfully requested.

Since all rejections, objections and requirements
contained in the outstanding official action have been
fully answered and shown to be in error and/or
inapplicable to the present claims, it is respectfully
submitted that reconsideration is now in order under
the provisions of 37 C.F.R. §1.111(b) and such
reconsideration is respectfully requested. Upon
reconsideration, it is also respectfully submitted that
this application is in condition for allowance and such
action is therefore respectfully requested.

If an extension of time is required for this
response to be considered as being timely filed, a
conditional petition is hereby made for such extension
of time. Please charge any deficiencies in fees and
credit any overpayment of fees to Deposit Account No.
09-0440 of International Business Machines Corporation
(Tucson).

Respectfully submitted,

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